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EXAMINER

FERGUSON, MICHAEL P

ART UNIT PAPER NUMBER

3679

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/816,706

Applicant(s)

PETROZZIELLO, LOUIS J.

Examiner

Michael P. Ferguson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-20 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/25/05</u> . | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
2. The information disclosure statement filed April 25, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the resilient insulation strips wrapped around the vertical posts claimed in claim 8 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, 7-10 and 12-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Fattore (US 4,767,419).

As to claim 1, Fattore discloses a combination including a fence and a protective guard comprising:

the fence having vertical posts **14,20,24** with upper ends and a top support bar **12** extending between the vertical posts;

a tubular member (outer sheet **50**) having first and second ends, an outer surface extending between the first and second ends, an inner surface extending between the first and second ends that defines an interior space, and a slot extending between the inner and outer surfaces and the first and second ends of the tubular member, wherein the tubular member is secured over an upper edge of the fence so that the upper ends of the vertical posts and the top support bar are captured within the interior space of the tubular member;

a spacer **52** positioned between the inner surface of the tubular member and the top support bar for supporting the tubular member between the vertical posts; and

insulation material **48** disposed in the slot and the interior space of the tubular member for sealing the interior space of the tubular member (Figures 1-4).

As to claim 2, Fattore discloses a combination wherein the spacer **52** has a height and wherein the upper ends of the vertical posts **24** extend above the top support bar **20** by a vertical distance that is substantially equal to the height of the spacer (Figure 3).

As to claim 3, Fattore discloses a combination wherein the spacer **52** has an upper end in contact (via insulation **48**) with the inner surface of the tubular member (outer sheet **50**) and a lower end in contact (via insulation **48**) with the top support bar **12** (Figure 3).

As to claim 5, Fattore discloses a combination wherein the insulation material **48** includes caps (closed end of outer sheet **50**) positioned within openings at the first and second ends of the tubular member (outer sheet **50**; Figure 2).

As to claim 7, Fattore discloses a combination wherein the insulation material **48** includes a resilient strip positioned within the slot (Figure 3).

As to claim 8, Fattore discloses a combination wherein the insulation material **48** includes a resilient strip wrapped around the vertical posts **20,24** (Figure 1).

As to claim 9, Fattore discloses a combination comprising first and second attachment flanges extending from the outer surface of the tubular member (outer sheet **50**) on opposite sides of the slot, wherein the attachment flanges are positioned on opposite sides of the fence when the protective guard is secured over the fence (Figures 2-4).

As to claim 10, Fattore discloses a combination comprising a securing element **40,42,44,46** in contact with the attachment flanges for securing the attachment flanges together on opposite sides of the fence (Figure 3).

As to claim 12, Fattore discloses a combination including a fence and a protective guard comprising:

the fence having vertical posts **14,20,24** with upper ends and a top support bar **12** extending between the vertical posts;

a tubular member (outer sheet **50**) having first and second ends, an outer surface extending between the first and second ends, an inner surface defining an interior space and a slot extending between the inner and outer surfaces and the first and second ends of the tubular member, wherein the tubular member is secured over an upper edge of the fence so that the upper ends of the vertical posts and the top support bar are captured within the interior space of the tubular member; and

a spacer **52** positioned within the interior space of the tubular member and in contact with the inner surface of the tubular member for supporting the tubular member between the vertical posts so as to prevent the tubular member from sagging between the vertical posts (Figures 1-4).

As to claim 13, Fattore discloses a combination comprising first and second attachment flanges extending from the outer surface of the tubular member (outer sheet **50**) on opposite sides of the slot, wherein the attachment flanges are positioned on opposite sides of the fence when the protective guard is secured over the fence (Figures 2-4).

As to claim 14, Fattore discloses a combination comprising a securing element **40,42,44,46** in contact with the attachment flanges for securing the attachment flanges together with a portion of the fence positioned between the attachment flanges (Figure 3).

As to claim 15, Fattore discloses a combination including a fence and a protective guard comprising:

the fence having vertical posts **14,20,24** with upper ends and a top support bar **12** extending between the vertical posts;

a tubular member (outer sheet **50**) having first and second ends, an outer surface extending between the first and second ends, an inner surface extending between the first and second ends, the inner surface defining an interior space, and a slot extending between the inner and outer surfaces and the first and second ends of the tubular member, wherein the tubular member is secured over an upper edge of the fence so

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that upper ends of the vertical posts and the top support bar are captured within the interior space of the tubular member; and

insulation material **48** disposed in the slot and the interior space of the tubular member for sealing the interior space of the tubular member (Figures 1-4).

As to claim 16, Fattore discloses a combination comprising first and second attachment flanges extending from the outer surface of the tubular member (outer sheet **50**) on opposite sides of the slot and a securing element in contact with the attachment flanges for securing the attachment flanges together with a portion of the fence positioned between the attachment flanges (Figures 2-4).

As to claim 17, Fattore discloses a combination wherein the tubular member (outer sheet **50**) and the first and second attachment flanges are integrally formed with one another (Figure 2).

As to claim 18, Fattore discloses a combination wherein the insulation material **48** includes a resilient material disposed in the slot of the tubular member (outer sheet **50**) and caps (closed ends of outer sheet **50**) sealing the first and second ends of the tubular member (outer sheet **50**; Figure 2 and 3).

As to claim 19, Fattore discloses a combination comprising a spacer **52** positioned within the interior space of the tubular member (outer sheet **50**) and in contact (via insulation **48**) with the inner surface of the tubular member for preventing the tubular member from sagging between the vertical posts **14,20,24** (Figure 3).

6. Claim 12 is rejected under 35 U.S.C. 102(b) as being anticipated by Naka et al. (US 4,220,316)

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As to claim 12, Naka et al. disclose a combination including a fence and a protective guard comprising:

the fence having vertical posts **46** with upper ends and a top support bar **24** extending between the vertical posts;

a tubular member **26** having first and second ends, an outer surface extending between the first and second ends, an inner surface defining an interior space and a slot extending between the inner and outer surfaces and the first and second ends of the tubular member, wherein the tubular member is secured over an upper edge of the fence so that the upper ends of the vertical posts and the top support bar are captured within the interior space of the tubular member; and

a spacer **25** positioned within the interior space of the tubular member and in contact with the inner surface of the tubular member for supporting the tubular member between the vertical posts so as to prevent the tubular member from sagging between the vertical posts (Figures 1, 8 and 9).

7. Claims 15-17 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoke (US 5,328,156).

As to claim 15, Hoke discloses a combination including a fence and a protective guard comprising:

the fence having vertical posts **16** with upper ends and a top support bar **28** extending between the vertical posts;

a tubular member **30** having first and second ends, an outer surface extending between the first and second ends, an inner surface extending between the first and

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second ends, the inner surface defining an interior space, and a slot extending between the inner and outer surfaces and the first and second ends of the tubular member, wherein the tubular member is secured over an upper edge of the fence so that upper ends of the vertical posts and the top support bar are captured within the interior space of the tubular member; and

insulation material **44** disposed in the slot and the interior space of the tubular member for sealing the interior space of the tubular member (Figures 1-4).

Applicant is reminded that the orientation of an object is based upon the angle at which it is viewed.

As to claim 16, Hoke discloses a combination comprising first and second attachment flanges extending from the outer surface of the tubular member **30** on opposite sides of the slot and a securing element in contact with the attachment flanges for securing the attachment flanges together with a portion of the fence positioned between the attachment flanges (Figure 2).

As to claim 17, Hoke discloses a combination wherein the tubular member **30** and the first and second attachment flanges are integrally formed with one another (Figure 2).

As to claim 20, Hoke discloses a combination wherein the fence is a chain link fence including a wire mesh secured to the top support bar **28** and the vertical posts **16** (Figure 1).

Applicant is reminded that the orientation of an object is based upon the angle at which it is viewed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fattore.

As to claim 4, Fattore discloses a combination wherein the tubular member (outer sheet 50) is made of vinyl (column 2 lines 58-60).

Fattore fails to disclose a combination wherein the tubular member is made of polypropylene.

The applicant is reminded that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a combination as disclosed by Fattore to have a tubular member made of polypropylene as such practice is a design consideration within the skill of the art.

As to claim 6, Fattore discloses a combination wherein the caps (closed ends of outer sheet 50) include a vinyl material (column 2 lines 58-60).

Fattore fails to disclose a combination wherein the caps include a polymer material.

The applicant is reminded that the selection of a known material based upon its

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suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify a combination as disclosed by Fattore to have caps made of a polymer material as such practice is a design consideration within the skill of the art.

Allowable Subject Matter

10. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

As to claim 11, Fattore discloses the claimed combination with the exception of wherein the first end of the tubular member has a reduced diameter that is adapted to slide within an opening at an end of an adjacent protective guard.

It would not have been obvious to one having ordinary skill in the art at the time the invention was made to modify a combination as disclosed by Fattore to have the above mentioned elements as the prior art neither teaches nor suggests such modifications.

Conclusion

The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. The following patents show the state of the art with respect to fence guards:

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Killman et al. (US 4,523,745), Meglino et al. (US 5,141,207) and Feigenbaum (US 5,437,071) are cited for pertaining to fence guards comprising a tubular member and insulation material.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Ferguson whose telephone number is (571)272-7081. The examiner can normally be reached on M-F (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571)272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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